

Remarks

Claim Objections

The Examiner objected to Claim 10 as being misnumbered. Applicants appreciate the Examiner's objection and thank the Examiner for renumbering Claim 10 to Claim 9.

Claim Rejections under 35 U.S.C. §112

The Examiner rejected Claims 1-9 under 35 U.S.C. §112 as being indefinite for failing to comply with the written description requirement. More specifically, the Examiner indicated that the claims contained subject matter that was not adequately described in the specification to reasonably convey that Applicant was in possession of the invention at the time the application was filed. Even more specifically, the Examiner indicated that the specification did not describe a power inlet and an auxiliary power outlet rated to provide an identical voltage. Applicants respectfully traverse the rejection inasmuch as the rejection may apply to the claims as amended.

Under U.S. Patent law, where a feature of an invention is inherent in the invention, the feature is disclosed in a patent application even though the application is silent as to the feature. In the present case, Figures 1, 2 and 3 of the present application illustrate common inlet and outlets for power cords. The use of common inlets and outlets for power cords, and more particularly, the illustration of common inlets and outlets in accordance International Electrotechnical Commission (IEC) standards implies that the inlets and outlets are capable of carrying an identical voltage. Additionally, Paragraph [0005] of the original specification states that male power inlet 12 may be connected to a power cord plugged into an outlet wired to a building power supply and that auxiliary power outlet 18 of the microscope stand may be used to

connect auxiliary components, such as cameras, monitors, etc. to a building power supply. Hence, because both inlet 12 and outlet 18 are operatively arranged to accept power from a building power supply, it necessarily follows that they are also adapted for providing an identical voltage.

In view of the above, reversal of the rejection is courteously requested.

Claim Rejections Under 35 U.S.C. §103

The Examiner rejected all pending claims under 35 U.S.C. §103 as being obvious in view of the previously cited Scanoptics publications and knowledge "well known" to one having ordinary skill in the art. Applicants respectfully traverse the rejection.

Regarding Claim 1 and those claims depending therefrom, the Examiner indicated that, "Scan Optics discloses the claimed invention except for said auxiliary power outlet rated to provide a first voltage identical to said power inlet. It is well known to one of ordinary skill in the art for an outlet to provide the appropriate voltage for the auxiliary device to be used with it. Therefore, it would have been obvious to one having ordinary skill in the art that at the time the invention was made to have the auxiliary power outlet provide any specific appropriate voltage, even one identical to said power inlet, to power a specific auxiliary device."

Under U.S. patent law, in proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki*, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant

teachings of the references. *In re Obukowicz*, 27 U.S.P.Q.2d 1063, 1065 (Bd. of Patent Appeals 1993); *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Additionally, when a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references and the teachings of the references can be combined only if there is some suggestion or incentive to do so. *In Re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), citing *In re Fine*. Moreover, the question of motivation to combine references is material to patentability and cannot be resolved on subjective belief and unknown authority. With respect to core factual findings in a determination of patentability, an Examiner cannot simply reach conclusions based on his/her own understanding or experience- or on his/her assessment of what would be "basic knowledge" or "common sense". Rather, an Examiner must point to some concrete evidence in the record to support such findings. *In re Zurko*, 59 USPQ 2d (CAFC 1693). Rarely will the skill in the art operate to supply missing knowledge or missing prior art to reach an obviousness judgment. *Al-Site Corp. v. VSI International Inc.*, 50 USPQ2d 1161 (CAFC 1999). Indeed, deficiencies of the cited references cannot be remedied by general conclusions about what is "basic knowledge," or "common sense. *In Re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), citing *In re Fine*. (emphasis added). Thus, when a rejection is based on "common knowledge", "common sense", or those facts within the personal knowledge of the Examiner, the Examiner is required under 37 CFR §104(d)(2), to produce data indicating that such knowledge is common or well known; "the data shall be as specific as possible, and the references must be supported, when called for by Applicant, by the Affidavit of such employee..." In the present

case, the Examiner has not met the required burden to establish a case of *prima facia* obviousness.

First, the Examiner has not presented any objective or factual evidence, other than bald assertion and conclusory statements in finding that it would have been obvious to create a microscope stand comprising standard power inlets and outlets rated for providing an identical voltage. Indeed, the Examiner has not identified a single reference that contains a teaching, a suggestion or the motivation to make the combination/modification. "The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 16 USPQ2d 1430 (Fed. Cir 1990).

Second, the Examiner has not presented any objective evidence to illustrate that the present invention would have been obvious in view of that knowledge "well known" and generally available to one having ordinary skill in the art. "Skill in the art does not act as a bridge over gaps in a substantive presentation in an obviousness case," and "bald conclusory statements standing alone are not evidence," *Al-Site Corp. v. VSI International Inc.*, 50 USPQ2d 1161 (CAFC 1999) (emphasis added); *In re Kotzab*, 55 USPQ2d 1313 (CAFC 2000). Simply put, the question of motivation to combine references is material to patentability and cannot be resolved on subjective belief and unknown authority. There must be some objective teaching, suggestion, or motivation contained in the prior art to make the combination/modification; absent such showing, the Examiner must illustrate by objective fact and evidence that such teaching, suggestion, motivation to make the combination/modification emanates from that knowledge

generally available to one having skill in the art. "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill in the art at the time the claimed invention was made' because the references relied upon teach all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facia* case of obviousness without some objective reason to combine the teachings of the references. MPEP §2143.01, citing Ex parte Levengood, 28 USPQ2d 1300 (Fed Cir 2000).

Third, the Examiner purports to assert that the motivation to make the combination/modification emanates from that knowledge "well known" and available to one having ordinary skill in the art. The Examiner states that it is "well known" to utilize auxiliary power outlets for providing an appropriate voltage for an auxiliary device, including inlets and outlets for providing an identical voltage. However, the fact that it may be "well known" to utilize appropriate inlets and outlets for an auxiliary device does not necessarily dictate that it is also "well known" and/or obvious to utilize standard power inlets and outlets rated for providing an identical voltage in a microscope stand. As a matter of fact, the references cited by the Examiner, which are representative of that knowledge generally available to one having ordinary skill in the art illustrate the contrary. The Scanoptics references cited by the Examiner describe microscope stands comprising inlets and outlets adapted for providing voltages that are different from one another and even describe providing wholly different currents! (DC current as opposed to AC). In addition, U.S. Patent No. 4,284,327 discloses a microscope stand comprising non-standard power outlets for affixing an auxiliary device which appears to comprise a proprietary

type inlet/outlet. Hence, the motivation to combine/modify as propounded by the Examiner does not emanate from that knowledge generally available to one having ordinary skill in the art.

Finally, the Scanoptics references and U.S. Patent No. 4,284,327 each teach away from the Applicants invention. As previously noted, the Scanoptics references disclose a microscope stand comprising power inlets and power outlets rated to provide different voltages and current types, not identical voltages and similar current types. U.S. Patent No. 4,284,327 discloses a microscope stand comprising proprietary type power inlets and outlets. As the Examiner may well know, the prior art must be considered as a whole, to include those references and portions thereof that teach away from the invention and/or the combination/modification. Hence, in view of the fact that the prior art cited by the Examiner teaches away from the Applicants' invention, the present invention is also non-obvious in this regard. *In re Hedges*, 228 USPQ 685 (CAFC 1986).

In sum, "there is nothing in the statutes or case law which makes 'that which is within the capabilities of one skilled in the art' synonymous with obviousness." Indeed, the Examiner's comments regarding what is "well known" to one having ordinary skill in the art comprise nothing more than "an assertion that one of ordinary skill in the relevant art would have been able to arrive at [Applicant's] invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness." *Ex Parte Gerlach and Woerner*, 212 USPQ 471 (PTBA 1980); *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993).

For the reasons set forth above, Applicants respectfully request reversal of the rejection of Claim 1 and those depending therefrom and/or request that the Examiner produce data, as required under 37 CFR §104(d)(2), to illustrate that the motivation to make the combination/modification propounded by the Examiner emanates from what is "well known" one having ordinary skill in the art of microscopes.

With regard to the rejection of Claim 5 and those depending therefrom, Applicants reassert their arguments made with respect to Claim 1 herein. Additionally, it should be appreciated that simply because power inlets and power outlets may be manufactured in accordance with international standards, it does not necessarily follow that it is also obvious to equip a microscope stand with standard inlets and outlets operatively arranged to provide an identical, or substantially similar, voltage. As a matter of fact, the Scanoptics references and U.S. Patent No. 4,284,327 illustrate the contrary and teach away from the Applicants invention. The Scanoptics references illustrate that inlets and outlets may be rated for providing different voltages and U.S. Patent No. 4,284,327 illustrates that non-standard inlets and outlets may be utilized in a microscope stand. Additionally, both references illustrate that differently rated and/or non-standard inlets and outlets may be used safely. Consequently, the Examiner's assertion that the motivation to provide a microscope stand comprising standard inlets and outlets rated to provide an identical voltage emanates from safety considerations is wholly unfounded and tenuous at best. Indeed, "an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely

by finding corollaries for the claimed elements would permit an examiner to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability." *In re Rouffet*, 47 USPQ2d 1453 (CAFC 1998).

In view of the foregoing, reversal of the rejection is requested and/or the Applicants request that the Examiner produce data, as required under 37 CFR §104(d)(2), to illustrate that the motivation to provide a microscope stand comprising standard inlets and outlets rated to provide an identical voltage emanates from safety considerations.

With regard to the rejection of Claim 7 and those depending therefrom, Applicants reassert their arguments above with regard to the rejection of Claims 1 and 5 above. Applicants acknowledge that desktop microscope stands are available in the art. However, the Examiner's assertion that it would have been obvious to one having ordinary skill in the art to make the stand of the Scanoptics a desktop type stand for purposes of making the device more portable is tenuous and improper under law.

First, the Scanoptics brochure illustrates a "free standing" microscope stand comprising foot pedals, wheels and the like for use in a surgical, operating room and laboratory type settings; in sum, the Scanoptics stand is not configured for desktop type applications. The present invention is specifically configured for desktop type applications, for example in a classroom/instructional type settings. Under current law, if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the invention

prima facia obvious. The modifications propounded by the Examiner would alter the principles of operation of the Scanoptics device as it is specifically configured to comprise a free standing microscope stand comprising foot pedals, wheels and the like for portability purposes. Hence, in view of the fact that the modifications to the Scanoptics microscope stand, from a free standing stand to a desk top type stand as suggested by the Examiner, would alter the very principles of operation of the Scanoptics microscope stand, Applicant's respectfully submit that the Scanoptics reference is not sufficient to render Applicant's invention obvious. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, the Scanoptics stand does not disclose, teach or suggest a microscope stand comprising an auxiliary power outlet rated to provide a voltage identical to the power inlet and teaches away from such configuration.

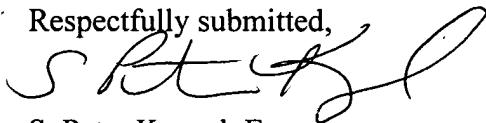
Second, the Scanoptics references (see Scanoptics 1350 brochure "Coaxial Video System") states that the device is "portable and robust". Hence, since the Scanoptics stand is already portable, it would not have been obvious to modify the Scanoptics stand to create a desktop type stand for purposes of making it portable as suggested by the Examiner. Simply put, the Scanoptics stand is already portable such that the Examiner's rationale for making it a desktop type stand for portability purposes is illogical and unreasonable.

For the reasons set forth above, Applicant respectfully requests reversal of the rejections.

Conclusion

Applicant respectfully submits that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,



S. Peter Konzel, Esq.
Registration No. 53,152
CUSTOMER NO. 24041
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564

SPK/

Dated: January 2, 2004